

REMARKS

Claim 21 has been amended to delete fragment language, elements 2(c) and (d). No new matter is added by these amendments and entry of the amendments is requested.

Election/Restriction

The Examiner stated that applicants traversal of the election of Group II in Paper No. 04222003 is acknowledged but the arguments that DNA and protein share a special technical feature is not found persuasive because there is no per se rule as to what shares a special technical feature and what does not. The Examiner stated that the structure of the DNA is extremely different from the structure of the protein and both have widely divergent activities. For these reasons, the Examiner stated, the DNA and protein lack a special technical feature. The requirement is deemed proper and therefore continues to be FINAL.

The Examiner stated further that part of applicants arguments is, however, convincing and the Examiner hereby rejoins composition claims 32 and 34 with claim 21. The question of rejoinder of method claims 36, 37 and 38 will be taken up when the protein claims are examined, should a divisional application be filed.

Applicants Response

Applicants reiterate that for the reasons previously given in the response filed November 7, 2003, specifically at page 11 of that response, Example 17, Part 2 of Annex B to the Administrative Instructions Under the PCT provides that unity of invention is accepted between a protein and the polynucleotide that encodes it. The protein and the DNA sequence encoding the protein exhibit corresponding special technical features. Thus the Instructions Under the PCT clearly provide that unity of invention exists in all cases between a polynucleotide sequence and its encoded protein, as in the instant case. Applicants therefore reserve the right under 37 CFR 1.144 to petition the restriction on these grounds no later than appeal on the case.

35 U.S.C. § 112, Second Paragraph, Rejection of Claims 22 and 26

The Examiner has maintained the rejection of claims 22 and 26 as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Examiner reiterated that the limitation of "claim 21" recited in the claims is indefinite because claim 21 remains withdrawn as drawn to a non-elected invention and

there is therefore insufficient antecedent basis for this limitation in the claims.

Applicants Response

Applicants reiterate that for the reasons previously given in response to the Restriction Requirement, the withdrawal of claim 21 as failing to comply with the unity of invention standard is improper and will be petitioned under 37 CFR 1.144. Therefore, further response to this rejection will be deferred until such time as said petition is submitted and acted upon.

35 U.S.C. § 112, First Paragraph, Rejection of Claims 22-24 and 26

The Examiner has rejected claims 22-24 and 26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Examiner stated that claim 22 claims DNA encoding biologically active fragments of the listed SEQ ID NOs and DNA encoding immunogenic fragments of the listed SEQ ID NOs. The scope of the instant claims is not commensurate with the enablement of the instant disclosure, because practice of the claimed invention would require undue experimentation by an artisan of ordinary skill in the art. The instant specification is not enabling for biologically active fragments or immunogenic fragments.

Applicants Response

Claim 21 has been amended to delete fragment language, and claims 22-24 and 26 no longer depend from a claim reciting this limitation. Withdrawal of the rejection of claims 22-24 and 26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement is therefore requested.

35 U.S.C. § 112, First Paragraph, Rejection of Claims 22-24 and 26

The Examiner has also rejected claims 22-24 and 26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As discussed above in the enablement rejection, the Examiner stated, the claims read on DNA encoding biologically active fragments and immunogenic fragments of the recited SEQ ID NOs. While applicants are in possession of all fragments since the entire sequences are disclosed, applicants have not demonstrated that they are in possession of fragments with the recited activities.

The Examiner stated that cancellation of the fragment language from the claims would overcome both rejections under 35 U.S.C. § 112, first paragraph.

Applicants Response

The claims have been so amended, and withdrawal of the rejection of claims 22-24 and 26 under 35 U.S.C. § 112, first paragraph is therefore requested.

Allowable Subject Matter

The Examiner has stated that claims 28-31, 35, 36 and 39 are allowed.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance, and request that the Examiner withdraw the outstanding objections/rejections. Early notice to that effect is earnestly solicited. Applicants also strongly urge the Examiner to reconsider the Restriction Requirement and examine claims 21, 32 and 34 relative to the protein sequences related to the elected polynucleotide sequence encoding them. Applicant further request that upon allowance of product claim 21, claims 37 and 38 be rejoined and examined as process claims limited in scope to allowable product claims in accordance with *In re Ochiai* and the MPEP § 821.04.

If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

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